

**THIS OPINION IS NOT A  
PRECEDENT OF THE T.T.A.B.**

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Bertucci

\_\_\_\_\_  
Serial No. 76646021

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Nathan E. Debaun of Ungaretti & Harris LLP for Denise A. Bertucci.

Nelson B. Snyder III, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop, Managing Attorney).

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Before Hairston, Drost, and Wellington, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

On September 1, 2005, Denise A. Bertucci, an individual, filed an application to register the mark FABULOUS FREDDIES ITALIAN EATERY (in standard characters) for "restaurants; namely restaurants providing take-out and fast food services" in International Class 43. The terms FABULOUS and ITALIAN EATERY are disclaimed. The application also contains a statement that "the name 'Frederick Bertucci' identifies a living individual whose consent is of record." The application is based on an

allegation that applicant has a bona fide intent to use the mark in commerce.

The examining attorney refused to register the mark under Section 2(d) of the Trademark Act based on a prior registration for the mark FABULOUS FREDDY'S for, *inter alia*, "retail store services featuring convenience store items and gasoline" in International Class 35. 15 U.S.C. § 1052(d).<sup>1</sup>

After the examining attorney made the refusal final, this appeal followed.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973).

However, as indicated in *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the relatedness of the goods/services at

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<sup>1</sup> Registration No. 3098172, issued May 30, 2006. The registration also covers services in International Class 37; however, the examining attorney concentrated his refusal based on a likelihood of confusion only with registrant's retail convenience store services. Section 8 affidavit accepted and Section 15 declaration acknowledged for the cited registration.

issue and the similarity or dissimilarity of the respective marks in their entireties.

We first consider the marks at issue. In doing so, we examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re Chatam International Inc.*, 380 F.3d

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1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In applying the aforementioned principles, we waste no time in discerning that the dominant element in applicant's mark is the phrase FABULOUS FREDDIES inasmuch as the remaining phrase ITALIAN EATERY is descriptive, if not generic, for applicant's services and is disclaimed. See *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987) (JM ORIGINALS with ORIGINALS disclaimed confusingly similar to JM COLLECTABLES). Although the term FABULOUS is laudatory (and also disclaimed), it is joined with FREDDIES due, in part, to the alliterative element. While we have not disregarded the ITALIAN EATERY phrase in our comparison of the respective marks, it is entitled to less weight than the arbitrary phrase FABULOUS FREDDIES. See *In re Chatam International Inc.*, 380 F.3d 1340; *In re National Data Corp.*, 753 F.2d 1056.

The dominant portion of applicant's mark, FABULOUS FREDDIES, is identical phonetically and very similar in appearance, connotation and commercial impression to the registered mark, FABULOUS FREDDY'S. The commercial impression created by both marks is that of touting a positive image ("fabulous") of a person (or persons) named "Freddy," who owns or has a connection to the services,

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whether true in actuality or not. Although applicant's mark utilizes the plural form of the nickname "Freddy," whereas the registered mark takes the possessive form of the same nickname, this will have little, if any, significance for consumers in distinguishing the parties' marks. Because of the very nature of applicant's and registrant's services, i.e., fast food services and retail convenience store services, we must assume that these services will reach ordinary consumers who will also likely be pressed for time. And, in determining likelihood of confusion, due to the normal fallibility of human memory over time, ordinary consumers retain a general rather than a specific impression of trademarks encountered in the marketplace. *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49 (Fed. Cir. 1986). Such fallibility is increased when the consumers are pressed for time and, again, the respective services are by their very nature catered to those who are pressured time-wise. Accordingly, upon viewing the marks, it is far more likely that consumers of applicant's and registrant's services will likely only retain the same general overall commercial impression from the two marks, that is, involving a "fabulous" person named "Freddy", rather than

distinguishing between one having a plural and the other having a possessive tense for the nickname.

We therefore find that the factor involving similarity of the marks weighs in favor of finding a likelihood of confusion.

We turn now to the similarity or dissimilarity of registrant's retail convenience store services and applicant's fast food and take-out restaurant services. In this regard, the examining attorney has attached a substantial amount of evidence that establishes a relationship between the respective services. Specifically, he has introduced several online articles and ample third-party website evidence demonstrating persuasively that many convenience stores, including those that also sell gasoline, will also provide fast food services or otherwise sell take-out meals.<sup>2</sup> One of these articles (from 2001) describes the idea of "placing restaurants inside convenience store/gas stations" as "one of the hottest trends of the fast-food industry."<sup>3</sup> Some excerpts from other articles submitted by the examining attorney include the following:

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<sup>2</sup> Attached to Office Actions dated April 23, 2007 and October 27, 2007.

<sup>3</sup> From The Clarion-Leader (Jackson, MS), March 8, 2001.

Subway first started broadening its location base in the early 1990s when it began opening restaurants inside convenience stores.

[The Wall Street Journal, September 1, 2006]

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[discussing a fire-damaged McDonald's restaurant]...The planned restaurant would have been inside a convenience store, not a free-standing building, in a grouping that includes a gas station.

[The Oregonian, July 11, 2005]

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Putting a quick-serve restaurant inside a convenience store also makes people stay longer, instead of just dashing in and out to pay for gas or buy a snack.

[Portland Press (Maine), March 16, 2002]

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In April, they started construction on the \$ 1.4 million gas station and convenience store. Taco Maker, Jake's Over the Top and Mayan Jamma Juice restaurants are inside the convenience store, accessible from U.S. 60 or Interstate 77...

[Charleston Gazette (West Virginia), December 25, 2000]

Putting a branded fast-food restaurant inside a convenience store may be a good way for c[onvenience] stores to boost traffic and for fast-food chains to gain prime real-estate sites, but some local convenience store operators - such as Wawa and Sheetz - have gone a long way in developing their own reputable foodservice brands.

[Nation's Restaurant News, January 6, 1997]

One of the third-party websites shows how a convenience store expanded by selling gasoline and now touts its ability to compete with fast-food restaurants:

Sheetz is a family owned convenience store chain based in Altoona, Pennsylvania. ...One year later [in 1973], Sheetz added gasoline pumps and introduced self-serve gasoline to central Pennsylvania. ...Sheetz has grown...with more than 330 locations across six states. ...It is popular belief that you can't get good tasting food at a convenience store. At Sheetz, we like to turn such conventions on their heads. We have developed a made-to-order program that rivals any quick serve restaurant you've ever visited.  
[from www.sheetz.com]

The articles and third-party website evidence demonstrates that consumers are not unaccustomed to receiving fast-food service in convenience stores. In some cases, the convenience stores will host a scaled down, separately-branded restaurant, whereas in other cases, the convenience store will render its own fast-food restaurant service. In either case, the convenience stores will be competing with fast-food restaurants by offering similar food items and vying for consumers who are seeking a quick meal.

The examining attorney also introduced thirty-nine (39) use-based third-party registrations which show that various entities have adopted a single mark under which they provide retail convenience store (or gasoline) services as well as restaurant services akin to registrants.<sup>4</sup> Third-party registrations which individually

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<sup>4</sup> Attached to Office Actions dated August 30, 2006; April 23, 2007; and October 27, 2007.

cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). These third-party registrations support a finding that applicant's restaurant services are related to registrant's retail store services featuring convenience store items and gasoline.

In view thereof, we find that there is clearly a relationship between the cited registrant's convenience store services and applicant's fast-food restaurant services. Consequently, the factor involving the similarity of the applicant's and registrant's services favors a finding of a likelihood of confusion.

As alluded to, we find that there is also an overlap in trade channels and consumers of the applicant's and registrant's services. Again, we are persuaded by the evidence of record that fast-food restaurant and convenience store services are commonly offered together - under the same roof. And, the same consumers who are seeking fast-food service may easily be lured to a convenience store offering such service.

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In summary, weighing all the relevant *du Pont* factors, we conclude that consumers who are familiar or otherwise acquainted with registrant's FABULOUS FREDDY'S mark for "retail store services featuring convenience store items and gasoline" would be likely to believe, upon encountering applicant's substantially similar FABULOUS FREDDIES ITALIAN EATERY mark for "restaurants; namely restaurants providing take-out and fast food services" that the respective services emanate from, or are sponsored by or affiliated with, the same source.

**Decision:** The examining attorney's refusal to register under Section 2(d) is affirmed.